

Reply Brief
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PATENT
Atty. Dkt. No. SEDN/5515

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Hendricks, et al.

Serial No.: 09/158,549

Confirmation No.: 4086

Filed: September 22, 1998

For: ADVANCED SET TOP TERMINAL
WITH ELECTRONIC MAIL BOX FOR
CABLE TELEVISION DELIVERY
SYSTEMS

§ Case Number: SEDN/5515

§ Group Art Unit: 2623

§ Examiner: Brown, Rueben

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Dear Sir or Madam:

REPLY BRIEF

Appellants submit this Reply Brief to the Board of Patent Appeals and Interferences in response to the Examiner's Answer dated October 17, 2007 in the Appeal of the above-identified application.

The Commissioner is authorized to charge any fees due, including extension of time and excess claim fees, to counsel's Deposit Account No. 20-0782/SEDN/5515.

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REMARKS

In Section 10 of The Examiner's Answer (Response to Arguments), the Examiner seems to emphasize the fact that the '074 application contains only one mention of electronic mail and asserts that the case law cited by the Appellants do not apply.

The Appellants are not aware of any case law or patent laws that require a minimum number of references to an embodiment of an applicant's invention. The Examiner asserts that because there is only one mention of electronic mail that the Appellants' claims are not supported by the parent application serial number 07/991,074, filed on December 9, 1992 (hereinafter the '074 application).

The Appellants respectfully submit that the requirements under 35 U.S.C. § 112, as described in the Appellants second appeal brief filed on July 6, 2007 only require that the "specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same . . ." Despite the fact that electronic mail is specifically referred to only once, the '074 application fully satisfies the requirements under 35 U.S.C. § 112.

As previously described, the '074 application clearly links the electronic mail capability to interactive features and then clearly teaches that the interactive features may be provided by a hardware upgrade. (See '074 application, p. 25, l. 19 – p. 26, l. 7). Moreover, the specification goes on to teaches that the hardware upgrade may include a microprocessor. (See '074 application, p. 57, l. 21 – p. 58, l. 1). Therefore, the Examiner's continued emphasis on how many times "electronic mail" was referenced is irrelevant to addressing whether or not the requirements of 35 U.S.C. § 112 are satisfied. As briefly summarized herein and outlined in detail in the second appeal brief filed by the Appellants on July 6, 2007, the '074 application clearly supports the Appellants' claims.

The Examiner also asserts that the case law cited by the Appellants is not applicable to the present appeal. The Examiner attempts to dismiss the case law cited by the Appellants by asserting that the "subject matter [is] not applicable to the electronic/computer arts." (See Examiner's response, p. 17, ll. 13-19). The Appellants

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respectfully submit that whether or not the subject matter of the patent applications at issue in the cited case law is similar to the subject matter of the application presently under appeal is irrelevant to the issue of whether case law is applicable.

Rather, the analysis is whether or not the facts of the case are analogous to the present appeal. Under such analysis, the facts of both cases cited by the Appellants are clearly applicable to the present appeal.

In *In re Skrivan*, the Examiner rejected the applicant's claims under 35 U.S.C. § 112 because there was no specific recitation in the rejected claims or specification of some limitation, specifically the angle at which two reactant containing streams were to be combined. *In re Skrivan* 427 F.2d 801, 805, U.S.P.Q. 85 (C.C.P.A. 1970). Similarly, in the present appeal, the Examiner is asserting that there is no specific recitation of some limitation. Specifically the Examiner asserts that the '074 application does not recite that the level B interactive unit receives and processes the electronic mail.

Under *In re Skrivan*, the Court overturned the Examiner's rejections because the specification and the claims may not be rejected for lack of written description under 35 U.S.C. § 112, first paragraph, when details in the claims that are not described in the specification are within the level of ordinary skill in the art. In the present appeal, the Appellants respectfully submit that the details the Examiner alleges are missing from the specification are within the level of someone with ordinary skill in the art. The Appellants '074 application clearly teaches that electronic mail is an interactive service that may be provided via a hardware upgrade. The Appellants' '074 application also clearly teaches the details of the hardware upgrade. Thus, one of ordinary skill in the art would recognize that the Level B interactive unit can receive and process electronic mail.

With respect to *In re Gay*, the Examiner rejected the applicant's claims under 35 U.S.C. § 112 because the specification failed to even mention, let alone give specific data as to the size and number of openings. *In re Gay* 309 F.2d 769, 772, 135 U.S.P.Q. 311 (C.C.P.A. 1962). The Examiner maintained a rejection under 35 U.S.C. § 112 because of failing to find "specific" details, similarly as alleged by the Examiner in the present appeal.

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Under *In re Gay*, the Court overturned the Examiner's rejection holding that "[n]ot every last detail is to be described, else patent specifications would turn into production specifications, which they were never intended to be." Thus, similar to the holdings by the Court under *In re Skrivan* and *In re Gay*, the Appellants' urge the Board to overturn the Examiner's rejections under 35 U.S.C. § 112.

In summary, the Appellants maintain that the Appellants' claims, as supported by the '074 application, fully satisfy the requirements of 35 U.S.C. § 112. Consequently, Handelman is not a proper reference against the Appellants' claims and, thus, the Examiner has also failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103. Therefore, the Appellants respectfully request the Board to reverse the Examiner's rejection of all claims.

CONCLUSION

Appellants respectfully request that the Board reverse the rejections and pass the claims to allowance.

Respectfully submitted,

12-17-07



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